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| 09/517,364 | 03/02/2000 | B. Scott Fabre | SLA0153:FCO | 5185 |

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| EXAMINER |
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DONAGHUE, LARRY D

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| ART UNIT | PAPER NUMBER |
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2154

DATE MAILED: 04/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/517,364

Applicant(s)

FABRE, B. SCOTT

Examiner

Larry D. Donaghue

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03/02/2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Claims 1-24 are presented for examination.
2. The rejections are maintained and set forth below.
3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claim 5 recites the limitation "specifically associated with " in step (a). There is insufficient antecedent basis for this limitation in the claim.
5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
6. Claims 1,2,3,6, 9,10,12,13, 21-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Stevenson et al. 6,819,455.

Stevenson et al. taught the invention (claim 1,2 and 21) as claimed including a method for executing a request to print said "print portion" (col. 3, lines 26-35); generating a "print portion" uniqueness identifier in a host computer, said "print portion" uniqueness identifier specifically referring to and for identifying said "print portion" (col. 3, lines 36-50); comparing said "print portion" uniqueness identifier to a list of uniqueness identifiers stored in memory (col. 1, lines 62-67, col. 3, lines 52-64); printing said "print portion" using previously rendered data stored in a memory location referenced by said list of uniqueness identifiers if said "print portion" uniqueness identifier is found in said list of uniqueness identifiers (col. 3, lines 52-64); and storing said "print portion" uniqueness identifier and a reference to data stored in memory pertaining to said "print portion" in said list of uniqueness identifiers if said "print portion" uniqueness identifier is not found in said list of uniqueness identifiers (col. 4, lines 12-25).
7. As to claim 3, Stevenson et al. taught printing said "print portion" printing an entire print job (col. 3, lines 52-64).
8. As to claim 6, Stevenson et al. taught performing an efficiency check (col. 4, lines 51-64). Determining that the proper files is used improves the overall efficiency of the system.

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9. As to claims 9, 12, and 22, Stevenson et al. taught comparing said "print portion" uniqueness identifier to a list of uniqueness identifiers stored in memory further comprising the step of comparing said "print portion" uniqueness identifier to a list of uniqueness identifiers stored in memory in a printer (col. 3, lines 37-50).

10. As to claim 10, 13, and 23, Stevenson et al. taught transferring said "print portion" uniqueness identifier from said host computer to said printer (col. 3, lines 37-50).

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 4, 5, 7, 8, 11, 14, 15-20, and 24 rejected under 35 U.S.C. 103(a) as being unpatentable over Stevenson et al. (6,819,455) as applied to claims 1,2,3,6, 9,10, 12,13, 21-23 above, and further in view of Mastie et al. (6,498,656).

13. As to claims 11, 14 and 24, Stevenson et al. did not teach transferring all or part of said "print portion" from said host computer to said printer if said "print portion" uniqueness identifier is not found in said list of uniqueness identifiers. Mastie et al. suggest the modification as it would reduce network traffic (col. 6, line 49- col. 7, line 11).

14. As to claims 4, 5, 7, 8, and 15-20, Stevenson et al. did not expressly teach taught printing said "print portion" printing a portion of an entire print job. Mastie et al. suggest the modification, segmenting print jobs into multiple files (col. 6, lines 49-57).

15. Claims 5 and 7 are multiple file version of claims 1,2, and 21 are rejected for the reason set forth in the rejections set forth in the rejection of claims 4 and 1,2, and 21.

16. Claim 8 is multiple file version of claim 6 and is rejected for the reason set forth in the rejections set forth in the rejection of claims 4 and 6.

17. Claims 15 and 18 are multiple file version of claims 9, 12 and 22 and are rejected for the reason set forth in the rejections set forth in the rejection of claims 4 and 9,12 and 22.

18. Claims 16 and 19 are multiple file version of claims 10, 13 and 23 and are rejected for the reason set forth in the rejections set forth in the rejection of claims 4 and 10,13 and 23.

19. Claims 16 and 20 are multiple file version of claims 11, 14 and 24 and are rejected for the reason set forth in the rejections set forth in the rejection of claims 4 and 11,13 and 24.

20. Applicant's arguments filed 04/06/2005 have been fully considered but they are not persuasive.

21. Applicant states All the independent claims currently pending in this application (claims 1, 2, 7, and 21) clearly include the step of generating a uniqueness identifier in a host computer." There is significant language in the specification that describe this step.

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22. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., checksum process) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

23. Applicant's claims 6 and 8 are directed to performing an efficiency check. The Examiner sites column 4, lines 51-64 of the Stevenson reference. as teaching an efficiency check. However, the cited section is directed to a secondary check to verify that the file to be printed is the same as the file stored in memory. There is no mention that this verification step in any way improves on the efficiency of the system. It appears that using the Stevenson process, if a previously rasterized is found in memory, it is retrieved and printed from recent memory without regards as to whether it is more efficient.

24. In response, one of ordinary skill in the art would recognize that it is more efficient not to repeat a process it is not necessary.

25. Examiner response to Applicant argument's directed to the 103 combination.

26. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

27. In response to applicant's argument that The Stevenson reference could not work with partial print jobs because each print job is only identified by identifiers suitable to identify the entire job (e.g. the name, version number, file size, and last saved date). Without a process for generating a uniqueness identifier for parts of the print portion, the invention as claimed in the currently pending claims simply could not be implemented. , the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

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28. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

29. This is a RCE of applicant's earlier Application No. 09/517,364. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Larry D. Donaghue whose telephone number is 571-272-3962. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571-272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LARRY D. DONAGHUE
PRIMARY EXAMINER

